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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,091	03/06/2002	Jerome Swartz	021XG	1517

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Kirschstein, Ottinger, Israel & Schiffmiller, P.C.  
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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/092,091

Applicant(s)

SWARTZ, JEROME

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE (06/02/03).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continuation Data***

1. Examiner suggests change of related case as follows:

5 In proposed specification amendments, line 5, substitute "08/292,584, filed August 18, 1994," with --08/292,584, filed August 18, 1994, now U.S. Patent 5,448,046,--.

### ***Continued Examination Under 37 CFR 1.114***

10 2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 2, 2003 has been entered.

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### ***Preliminary Amendment***

3. Receipt is acknowledged of the preliminary amendment filed on June 2, 2003. In the preliminary amendment, claims 30-39 were canceled, and claims 40-49 were newly added. Accordingly, claims 40-49 remain for examination.

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### ***Obviousness-Type Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise

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extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 40-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of US Patent 5,448,046 to Swartz et al. ('046 patent hereinafter).

Although the conflicting claims are not identical, it is the Examiner's view that they are not patentably distinct from each other.

In claim 40 of the instant application, the Applicant claims "a method of processing products in a point-of-sale system comprising customer price information stations, customer check-out sites, and a host computer coupled to the customer price information stations, the method comprising the steps of : a) storing information relating to the products in a database of the host computer; b) presenting selected products bearing no human-readable price information to said customer price information stations; c) identifying the selected products by electro-optical reading indicia associated with the selected products, the indicia having parts of different light reflectivity; d) interrogating the host computer on a real-time bases for price information on each identified product; e) printing an adhesive paper label containing human-readable price information relating to each identified product obtained from the host computer; f) adhering each printed paper label to each identified product at said customer price information stations; and g)

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presenting the products with the respective adhered labels at said customer check-out sites to complete purchase of the products.”

Claim 7 of '046 patent recites “An arrangement for expediting commercial transactions of products at a point-of-transaction terminal, comprising (a) a computer having a data base in  
5 which product identity information and data corresponding to attributes of each product are stored; (b) a tag bearing coded indicia having parts of different light reflectivity situated adjacent to each of the products, each coded indicia representing the identity of a respective product; (c) means for electro-optically scanning and reading the coded indicia on the tag situated with a product visually selected by a human operator, including means for directing a light beam  
10 exteriorly of the reading means, and means for movably positioning the light beam on the coded indicia on the tag of the selected product to automatically identify the selected product to the host computer and produce a signal when such identification is successfully made; (d) means for accessing the data base on a real-time basis in automatic response to said signal from the reading means to retrieve the stored data corresponding to the to an attribute associated with each  
15 identified product; (e) means for printing attribute information corresponding to the retrieved data on a label for each identified product on a real-time basis with the operation of the means for accessing the data base; (f) adhesive means for adhering the printed label to each identified product; and (g) means for completing a commercial transaction at the point-of-transaction terminal by electro-optically reading the attribute information on the printed label on a product  
20 presented to the point-of-transaction terminal.”

Although some terms are different, for example, point-of-sales and point-of-transaction, it is the Examiner's view that they refer to same functional apparatus for a customer to initiate

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and complete commercial transactions. Product attribute information disclosed in '046 patent can be interpreted somewhat broader than "human-readable price information" recited in the instant application, however, since product attribute can include price information, among other things, they are not patentably distinct. In fact, using claims of '048 patent as a general teaching, one ordinary skill in the art would choose to print only relevant information on the product among many attribute information. Both instant application and '046 patent also rely on use of product database and real-time accessing of product information. Both also disclose printing of label per item at the checkout terminal.

To the extent that the instant claim is broader/identical and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

### ***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Sato et al. (US 4,734,710); Rando et al. (US 4,939,355); Christopher et al. (US 5,227,617); Gupta (US 5,382,779) disclose various scanner and checkout terminal.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

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*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim  
Patent Examiner  
Art Unit 2876

15 July 7, 2003

  
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